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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,947	08/20/2001	Ulrich Reinehr	BAYER 10,219	5904

7590

08/26/2003

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EXAMINER

TENTONI, LEO B

ART UNIT

PAPER NUMBER

1732

DATE MAILED: 08/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,947

Applicant(s)

REINEHR ET AL.

Examiner

Leo B. Tentoni

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1732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3, 5, 7-13, 15-19, 23-25, 27, 29, 30 and 32 is/are allowed.
- 6) ☒ Claim(s) 4, 6, 14, 20-22, 26, 28, 31 and 33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.6
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Specification*

2. The disclosure is objected to because of the following informalities: Appropriate headings should be used throughout the instant specification.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 4, 6, 20-22, 26, 28, 31 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, ``step h)'' does not have clear and proper antecedent basis in the claims because instant claim 1 does not recite a step h).

In claim 6, it appears that ``step f)'' should be - - step e) - - (because this is a mixing step in instant claim 1).

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In claims 20-22 and 31, it is not clear what units ``mn'' represent.

In claim 33, there appear to be word(s) missing at the end of this claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Reinehr et al (DE 19504316 C1).

Reinehr et al (see the entire document, in particular, Tables 1-4) teach elastane fibers having a titer of up to 10,000 dtex (i.e., a titer less than, or equal to, 10,000 dtex), fiber (or tensile) strengths of 0.5 to 0.95 cN/dtex and an elongation at tear (or break) of 500 to 750%. Note that claim 14 is a product-by-process claim, and even though product-by-process claims are limited by and defined by the process, the determination of patentability is based on the product itself and does not depend on its process of production (In re Pilkington, 411 F.2d 1345, 162 USPQ 145 (CCPA 1969); In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983); In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985)).

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**Allowable Subject Matter**

7. Claims 1-3, 5, 7-13, 15-19, 23-25, 27, 29, 30 and 32 are allowable over the prior art references presently of record.

8. Claims 4, 6, 20-22, 26, 28, 31 and 33 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

9. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art references presently of record, alone or in combination, disclose, suggest or teach a process of making elastane fibers using spinning solutions of elastane recycled material including the step of introducing a secondary aliphatic amine into the spinning solvent as set forth in instant claim 1. None of the prior art references presently of record, alone or in combination, disclose, suggest or teach an apparatus for making elastane fibers including at least one heatable mixing tank with an inlet for solid material, a dispersing unit and a cooling zone with mixing elements as set forth in instant claim 15.

**Conclusion**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent 5,961,908 is of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leo B. Tentoni whose telephone number is (703) 308-3834. The examiner

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can normally be reached on Monday - Friday (6:30 A.M. - 3:00 P.M.).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni can be reached on (703) 305-5493. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*Leo B. Tentoni*

Leo B. Tentoni  
Primary Examiner  
Art Unit 1732

lbt